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IBM CORPORATION,  
INTELLECTUAL PROPERTY LAW  
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3605 HIGHWAY 52 NORTH  
ROCHESTER MN 55901-7829

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**OFFICE OF PETITIONS**

In re Application of :  
Emerick et al. :  
Application No. 09/865,371 : ON APPLICATION  
Filed: May 25, 2001 : FOR  
Atty Docket No. ROC920010109US1: PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705) filed January 22, 2008<sup>1</sup>.

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for

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<sup>1</sup> This application was timely filed with payment of the Issue Fee on January 22, 2008.

seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 595 days for Office delay and the periods of reduction of 26 and 2 days for applicant delay (in association with the responses filed July 7, 2004 and January 30, 2004). No mention of the other adjustments and reductions of record are made. In this regard, applicants are advised that the period of reduction of 41 days entered for applicant delay pursuant to 1.704(c)(8)<sup>2</sup> is correct. The supplemental response, an IDS filed January 31, 2005, was filed 41 days after the initial response filed December 21, 2004. Moreover, the IDS was not expressly requested by the examiner and did not include a § 1.704(d) statement<sup>3</sup>. Likewise, the period of adjustment of 7

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<sup>2</sup> 37 CFR 1.704(c) (8) provides that the following is a "failure to engage": Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

<sup>3</sup> 37 CFR 1.704 (d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any

days entered for Office delay pursuant to 1.703(a)(4)<sup>4</sup> is correct. An appeal brief in compliance with 1.192 was filed on February 5, 2007. The first relevant Office action thereafter was the mailing of a non-final Office action on June 12, 2007, four months and 7 days later.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

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individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

<sup>4</sup> 37 CFR 1.703(a)(4) provides that: The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 1.192 was filed and ending on the date of mailing of any of an examiner's answer under § 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;